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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/805,707

03/22/2004

Henri Brisebois

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27777

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06/02/2006

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EXAMINER

WOLLSCHLAGER, JEFFREY MICHAEL

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/805,707

Applicant(s)

BRISEBOIS ET AL.

Examiner

Jeff Wollschlager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/22/04</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, drawn to a die for impressing a material, classified in class 425, subclass 363.
- II. Claim 18, drawn to a sanitary napkin classified in class 604, subclass 358.
- III. Claims 19-24, drawn to a method of making a die, classified in class 264, subclass 219.
- IV. Claims 25-38, drawn to a method of impressing a material, classified in class 264, subclass 284.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a materially different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the apparatus can be used for making a materially different product such as embossed paper or embossed paper cups.

Inventions I and and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process

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(MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process such as metal stamping the projections into the die body.

Inventions I and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice a materially different process such as a process for extruding material with flow channels actively introduced during the extrusion process.

Inventions II and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used for making a materially different product such as embossed paper or embossed articles.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different modes of operations.

Inventions III and IV are directed to related processes. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are

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either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, the processes have a materially different mod of operation and effect.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Paul Higgins on May 24, 2006 a provisional election was made without traverse to prosecute the invention of Group IV, claims 25-38. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 27 recites that it depends from claim "265". There is no claim 265 pending in the application. For the purposes of examination, the claim is understood to depend from independent claim 25.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 25-32 and 34-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Weiher et al. (U.S. Patent Application Publication 2005/0035492; filed August 14, 2003).

Regarding claim 25, Weiher et al. (hereafter Weiher) teach a method of impressing a material at a plurality of discrete locations in the manufacture of an article comprising (Abstract): providing a die having a plurality of fields where each field has at

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least two projections arranged to engage the material substantially simultaneously; applying in succession each of said plurality of fields of projections to the surface of the material such as to apply a compressive force to the surface where the projections in each field define a total contact area over which the compressive force is applied; the total contact area of the projections in each field being such that the pressure applied by each individual field is not more than double the pressure applied by any other individual field (paragraphs [0074;0061-0064; 0071-0073]; Figures 4, 6 and 6A).

As to claim 26, Weiher teaches controlling the pressure such that it is essentially the same across the areas of application (paragraph [0074]).

As to claims 27, 28 and 34, Weiher teaches the projections are arranged to engage the material at different times through the use of a rotary die (Figures 3 and 4; paragraph [0057]). Further, the projections extend generally parallel to the axis of rotation (paragraph [0064]).

As to claims 29-31, Weiher discloses at least one field with a first zone of projections within an inherent imaginary boundary and a second zone of projections external to the imaginary boundary corresponding to a peripheral edge of the article that are either continuous or discontinuous with each other (paragraphs [0057-059 and 0064]; Figures 6 and 6A).

As to claim 32, the fields taught by Weiher define a sealing pattern for impressing the material of the article to form a peripheral seal wherein the sealing pattern forms a sanitary napkin (Figure 4; paragraph [0023]).

As to claim 35, Weiher teaches the spacing between the projections is chosen to apply a selected embossing force/pressure to the impressed article. (paragraphs [0065, 0074]). As such, for the production of the articles taught by Weiher, this requires different spacing to achieve the desired embossed affect between some of the adjacent fields.

As to claim 36, Weiher teaches the different fields have different individual contact areas, as needed, to achieve the desired embossed affect (paragraphs [0074; 0071-0073]).

As to claims 37 and 38, the material employed by Weiher includes a fluid-pervious layer and a liquid-impervious layer (paragraphs [0030-0037]).

Claims 25-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Amend et al. (U.S. Patent Application Publication 2003/0183053; published October 2, 2003; filed March 28, 2002).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 25, Amend et al. (hereafter Amend) teach a method of impressing a material at a plurality of discrete locations in the manufacture of an article



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comprising (Abstract): providing a die having a plurality of fields where each field has at least two projections arranged to engage the material substantially simultaneously; applying in succession each of said plurality of fields of projections to the surface of the material such as to apply a compressive force to the surface where the projections in each field define a total contact area over which the compressive force is applied; the total contact area of the projections in each field being such that the pressure applied by each individual field is not more than double the pressure applied by any other individual field (paragraphs [0003, 0007, 0015, 0016, 0037, 0055-0057]; Figures 6-8).

As to claim 26, Amend teaches the pressure is to be the same (paragraph [0003]).

As to claims 27, 28 and 34, Amend teaches the projections of the different fields are arranged on the die to engage the material at different times (Figure 1a) and the die is a rotary die with the projections generally parallel to the axis of rotation (paragraph [0031]).

As to claims 29-31 Amend discloses at least one field with a first zone of projections within an inherent imaginary boundary and a second zone of projections external to the imaginary boundary corresponding to a peripheral edge of the article that are either continuous or discontinuous with each other (Figures 5-8 provide examples).

As to claims 32 and 33, the fields taught by Amend define a sealing pattern for impressing the material of the article to form a peripheral seal wherein the sealing pattern forms a sanitary napkin and a sanitary napkin flap (Figures 6-7).

As to claim 35, Amend teaches the spacing between the projections is chosen to apply a selected embossing pressure to the impressed article at the desired location (paragraph [0057]). As such, this requires different spacing to achieve the desired embossed affect between the adjacent fields (Figure 8).

As to claim 36, Amend teaches the different fields have different individual contact areas to achieve the desired embossed affect (paragraph [0057])

As to claims 37 and 38, Amend teaches that fluid-pervious and liquid-impervious materials may be employed and impressed to form seals joining the layers (paragraph [0059]).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 33 is rejected under 35 U.S.C. 103(a) as being obvious over Weiher et al. (U.S. Patent Application Publication 2005/0035492; filed August 14, 2003).

As to claim 33, Weiher teaches the method of claim 32 as discussed in the 102(e) rejection above and further teaches making a sanitary napkin. Weiher does not explicitly teach the sanitary napkin has a flap. However, it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to add a flap to the sanitary napkin taught by Weiher for the purpose of providing a means to hold the napkin in place. Further, Weiher teaches the method is useful for making infant diapers. Infant diapers intrinsically have a flap. As such the claimed invention is rendered *prima facie* obvious over the teaching of the prior art.

### ***Conclusion***

All claims are rejected.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Canadian Patent Document CA 2122419 (submitted with IDS) correlates the pressure applied to the surface of the pressed material with the resultant conditioning of the material (page 23, lines 4-18).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Wollschlager whose telephone number is 571-272-

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8937. The examiner can normally be reached on Monday - Thursday 7:00 - 4:45, alternating Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JW

Jeff Wollschlager  
Examiner  
Art Unit 1732

May 26, 2006

  
CHRISTINA JOHNSON  
PRIMARY EXAMINER  
5/31/06